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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,491	06/17/2005	Ralf Wolleschensky	GK-ZEI-3278/500343.20298	2400

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REED SMITH, LLP  
ATTN: PATENT RECORDS DEPARTMENT  
599 LEXINGTON AVENUE, 29TH FLOOR  
NEW YORK, NY 10022-7650

EXAMINER
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VALENTIN, JUAN D

ART UNIT	PAPER NUMBER
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2877

MAIL DATE	DELIVERY MODE
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04/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,491	<b>Applicant(s)</b> WOLLESCHENSKY ET AL.	
	<b>Examiner</b> JUAN D. VALENTIN	<b>Art Unit</b> 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/17/2005</u> .                                              | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 06/17/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Citing the U.S. Patent number or publication number along with each foreign reference cited is not sufficient, should applicant wish to have both U.S. patent publications and the foreign reference considered, applicant must submit copies of all the foreign references as well as cite the US. Patent publications properly in an I.D.S.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 33, the phrase "preferably" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "preferably"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). The scope of the claim can not be determined, either the dispersion means is adjustable or it isn't.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23-33, 36-41, 44-47 rejected under 35 U.S.C. 102(b) as being anticipated by Simon (USPN '041 B1).

**Claims 23-31**

Simon discloses an apparatus/arrangement (claims 26, 27) to carry out a method for the optical examination and/or processing of a sample, comprising the steps of generating a short-pulse illumination light, splitting the illumination light spectrally for generating parallel (claims 24, 28, 29) spatially separated spectral components with pulse lengths that are greater than the pulse length of the illumination light source (claims 25, 30, 31, col. 2, line 59-col. 3, line 13), said spectral components traversing transmission optics in the direction of the sample, focusing the illumination light on or in the sample, wherein the spectral components are superposed, and detecting the sample light (col. 1, line 54-col. 3, line 48).

**Claims 32, 33**

Simon as applied above further discloses an adjustable dispersion means (Fig. 1, ref. PU 2).

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**Claims 36-41**

Simon discloses the use of both prisms and gratings which act as collimators and a plane plate (col. 2, line 59-col. 3, line 13).

**Claims 44-47**

Simon discloses adjusting the pulse width (using a compensating element) using adjustable optical elements (col. 3, lines 28-48).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34, 35, 42, 43, 48-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Simon.

**Claims 34, 35**

Simon discloses the use of an optical fiber to couple spectrally dispersed measurement light to a measurement sample (Fig. 1, Ref. 4, col. 3, lines 3-7). However, Simon fails to disclose the use of a fiber bundle to couple measurement light a sample surface. It is well known in the art to use optical fibers singularly or in fiber bundles in order to couple measurement light through optical measurement systems.

**Claims 42, 43**

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Simon discloses the use of prisms while not specifically referring to them as "direct-vision" prisms. Examiner has read the specification as originally filed and can not find anything critically distinguishing through the use of "direct-vision" prisms versus the prisms as taught by Simon which establishes novelty over prior art disclosure. Therefore it is the position of the Office that the prisms taught by Simon read on applicants claim limitations.

**Claims 48-61**

As shown in the rejection to Simon as applied above, the apparatus is anticipated by known prior art. Simon clearly shows the use of the invention in a laser scanning microscope (abstract, col. 2, line 59-col. 3, line 13). It is the position of the Office that while not explicitly stating its use in a fluorescence or multiphoton microscope or what specific samples are being processed, it is well within the knowledge of one of ordinary skill in the art at the time of the claimed invention that such an invention would be used in the field of biological research, which includes tissue research among a plethora of other possible uses for such a device. Merely claiming that a device can be used in multiple types of microscopes, and for multiple different purposes is not enough to distinguish patentability over prior art disclosure. In light of the applicants disclosure, there is no critically distinguishing feature in the applicants disclosure that exemplifies novelty over prior art disclosure. Therefore producing the same results as the applicant's limitations, the reference of Simon reads on applicants claimed limitation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUAN D. VALENTIN whose telephone number is (571)272-2433. The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory J. Toatley, Jr./  
Supervisory Patent Examiner, Art Unit 2877  
31 March 2008

Juan D Valentin II  
Examiner  
Art Unit 2877

JDVII  
March 26, 2008